

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Pat. No. 7,759,082

Issued: July 20, 2010

Inventor: Gary L. Bowen, et al.

U.S. Ser. No.: 10/764,691

Filed: January 26, 2004

For: ELECTROPROCESSED FIBRIN-BASED
MATRICES AND TISSUES

Confirmation No.: 9462

Attorney Docket: OGA-007.03

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

To the Commissioner for Patents:

Patentee requests reconsideration under 37 C.F.R. § 1.705(d) of the patent term adjustment (“PTA”) indicated in the Issue Notification and on the face of the patent. The fee required under 37 C.F.R. § 1.18(e) has been paid electronically. To the extent this Request is deemed a petition under any other section of 37 C.F.R. Part 1, the Commissioner is authorized to charge any other fee required by the filing of this paper to Deposit Account No. 06-1448, ref. OGA-007.03.

The Issue Notification and Patent indicated a PTA of 410 days. For the reasons given below, Patentee requests correction of the PTA to 440 or 454 days.

This request for reconsideration is timely because it is filed within two months of the date the patent issued.

A. Statement of Facts

1. Correct PTA and bases under § 1.702.

The correct PTA is 440 or 454 days. The patent is entitled to PTA under 37 C.F.R. §§ 1.702(a) and (b).

2. Relevant dates as specified in §§ 1.703(a)-(e) and adjustment as specified under 1.703(f).

a. Application No. 10/764,934 was filed under 35 U.S.C § 120 on January 26, 2004.

b. A Restriction Requirement was mailed on June 28, 2006, which was 459 days after the date that was 14 months after the filing date (i.e., March 26, 2005).

c. The application had been pending for 3 years as of January 26, 2007.

d. Applicants filed a first Request for Continued Examination under 35 U.S.C. § 132(b) on April 1, 2008.

e. The patent issued on July 20, 2010.

f. The pendency time after the 3-year period not consumed by continued examination was 430 days.

g. The total delay under 37 C.F.R. § 1.702(a)(1) was 459 days, the time period from March 26, 2005 to the mailing of the Restriction Requirement on June 28, 2006.

h. The total delay under 37 C.F.R. § 1.702(b) was 430 days, the time period from the beginning of the 3 year pendency on January 26, 2007 to the filing of the request for continued examination on April 1, 2008.

i. The delays specified in paragraphs (f) and (g) total 890 days.

j. The delays specified in paragraphs (f) and (g) do not overlap. The delay specified in paragraph (g) ended June 28, 2006. The delay specified in paragraph (f) did not begin until January 26, 2007.

k. The adjustment as specified in 37 C.F.R. § 1.703(f) to which the patent is entitled is 890 days, less the sum of the periods calculated under 37 C.F.R. § 1.704 addressed below.

3. The patent is not subject to a terminal disclaimer.

4. Circumstances constituting failure to engage in reasonable efforts.

a. Patentee's reply under 37 C.F.R. § 1.111 of December 20, 2006 was filed 83 days after the date that was three months after the Notice was mailed.

b. Patentee's reply under 37 C.F.R. § 1.111 of August 27, 2007 was filed 93 days after the date that was three months after the Notice was mailed.

c. Patentee's first Request for Continued Examination of April 1, 2008 was filed 59 days after the date that was three months after the final action of October 30, 2007 was mailed.

d. Patentee's reply under 37 C.F.R. § 1.111 of November 17, 2008 was filed 93 days after the date that was three months after the prior action was mailed.

e. Patentee's Information Disclosure Statement filed December 11, 2008 was filed 24 days after the date that Applicants filed a response to a non-final office action (on November 17, 2008).

f. Patentee's second Request for Continued Examination of June 12, 2009 was filed 61 days after the date that was three months after the final action of January 1, 2009 was mailed.

g. Patentee's reply under 37 C.F.R. § 1.111 of November 20, 2009 was filed 23 days after the date that was three months after the prior action was mailed.

h. Patentee filed an Amendment after Allowance under 37 C.F.R. § 1.312 on June 8, 2010 to correct a clerical error in the priority claim data caused by the Office. Specifically, Patentee submitted a preliminary amendment on March 1, 2004 to amend the priority claim and request a corrected filing receipt. Patentee amended the Specification to reflect that the instant patent is a continuation-in-part of U.S. Patent Application No. 09/714,255. However, the Office erroneously listed the application as a continuation of U.S. Patent Application No. 09/714,255. Patentee discovered the Office's mistake only when reviewing the application in preparation to pay the issue fee.

i. The Amendment after Allowance was necessitated by the Office's mistake.

j. A response to Patentee's Amendment after Allowance was issued by the Office on June 22, 2010, 14 days after the date of the filing of the amendment.

k. Patentee's total delay under 37 C.F.R. § 1.704 was 436 days, which is the total of the delays specified in paragraphs (a) through (g). If the delay specified in paragraph (j) is included, Patentee's total delay was 450 days. The adjustment as specified in 1.703(f) to which the patent is entitled is reduced, therefore, by either 436 or 450 days.

l. The adjustment as specified in 1.703(f) to which the patent is entitled is 454 days (if (j) delay is excluded) or 440 days (if (j) delay is included).

B. Applicable Law and Regulations

The period of deduction is determined under 1.704(c)(10)(i), which provides as follows:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, *beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;* (emphasis added)

C. Argument

The Patentee requests correction of the PTA because Patentee's total delay of 436 days or 450 days differs from the 479 days reported by the Office.

Part of this discrepancy results simply from the Office's failure to acknowledge its response to the 1.312 amendment as ending the period of delay caused by the filing of the 1.312 amendment.

In the present case, the PTO used the July 20, 2010 issue date of the patent as the end period in calculating the reduction period, attributing 43 days of delay to Patentee. However, the date of the PTO's response to the 1.312 amendment (June 22, 2010) should have been used as the end date in calculating the reduction period under 1.704(c)(10)(i). Thus, the delay period is at most 14 days.

But even that delay should not be tolled to Patentee, because the amendment was necessary to correct a clerical error by the PTO in recording the priority data. Applicants before the U.S. Patent and Trademark Office are entitled to expect that the Office's handling of their cases will be reasonably free of errors. In this case, the Office made a subtle but significant and avoidable error. Patentee promptly corrected the error when it became aware of it. It is unfair to penalize Patentee for correcting an error that it did not cause. Thus, the entire delay associated with the filing of the 1.312 Amendment should be disregarded and the patent awarded a PTA of 454 days. At the very least, the PTA should be corrected from 410 days to 440 days for the reasons given above.

D. Conclusion

For these reasons, Patentee's patent is entitled to 454 days' adjustment under 37 C.F.R. § 1.703(f). Alternatively, Patentee's patent is entitled to 440 days' adjustment. Please reconsider and revise the PTA, and please issue a certificate of correction reflecting the revised adjustment.

Respectfully submitted,
FOLEY HOAG LLP

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Customer Number 25181

Patent Group
Foley Hoag LLP
155 Seaport Blvd.
Boston, MA 02210-2600
Tel: (617) 832-1738
FAX: (617) 832-7000

/SCOTT E. KAMHOLZ/

Scott E. Kamholz, Reg. No. 48,543